

Remarks

Consideration and allowance of the claims presented herewith are respectfully requested. Claims 1, 3-13, 15-29 & 31-37 remain pending.

Initially, Applicants request withdrawal of the double patenting rejection to prior claims 1, 13, 25, 28, 29 & 31. Independent claims 1, 13, 25, 28 & 29 are amended herein to include the subject matter of the respective canceled dependent claims 2, 14 & 30. These amendments are believed to render moot the non-statutory obviousness-type double patenting rejection.

By this amendment, independent claims 1, 13, 25, 28 & 29 are amended to specify that the unused space available in the central queue includes *vacated allocated space* and *unallocated space* available in the central queue, and the actively managing includes separately tracking the vacated allocated space and the unallocated space currently available in the central queue. Further, the independent claims are amended to expressly define *vacated allocated space* and *unallocated space*, and to specify that the actively managing includes allocating differently the vacated allocated space and the unallocated space to the plurality of ports. Support for the amendments to the independent claims can be found in canceled dependent claims 2, 14 & 30, as well as paragraphs [0015], [0021], [0024] & [0025] of the specification. No new matter is added to the application by any amendment presented.

Original claims 1-37 were rejected under 35 U.S.C. §102(b) as being anticipated by Valizadeh (U.S. Patent No. 5,838,994; hereinafter Valizadeh). This rejection is respectfully traversed to any extent deemed applicable to the claims presented herewith, and reconsideration thereof is requested.

As noted, each of the independent claims now recites in part the subject matter of canceled claims 2, 14 & 30. In addressing these prior dependent claims, the Office Action notes that Valizadeh teaches a method for managing memory buffer and controlling the available space in the memory, and then asserts that Valizadeh is therefore inherently separately tracking space in the memory, as recited by Applicants. This conclusion is respectfully traversed to any extent deemed applicable to the independent claims presented herewith.

The doctrine of inherency is well-settled in patent law, and is best described in an excerpt from Hansgirk v. Kemmer, 26 C.C.P.A. 937, 102 F.2d 212, 40 U.S.P.Q. 665 (1939):

Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient. [citations omitted.] If, however, the disclosure [of the cited reference] is sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function, it seems to be well settled that the disclosure should be regarded as sufficient [to anticipate the claimed invention].

Id. at 940, 102 F.2d at 214, 40 U.S.P.Q. at 667; Stoller v. Ford Motor Co., 18 U.S.P.Q. 2d 1545, 1547 (Fed. Cir. 1991); Tyler Refrigeration v. Kysor Industrial Corporation, 227 U.S.P.Q. 845, 847 (Fed. Cir. 1985); Ex parte Levy, 17 U.S.P.Q. 2d 1461, 1464 (B.P.A.I. 1990); In re Oelrich and Divigard, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981).

In Ex parte Levy, the court stated that “[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art.” Ex parte Levy, 17 U.S.P.Q. 2d at 1464 (lengthy citation omitted) (italics added). The Office Action fails to present any line of reasoning why the recited functionality of Applicants’ invention *necessarily* flows from the teachings of Valizadeh, and thus, Applicants respectfully request reconsideration and withdrawal of the anticipation rejection against the claims presented.

In Applicants’ claims, there is active management of space allocations by, in part, a separate tracking *vacated allocated space* and *unallocated space* available in the central queue. A careful reading of Valizadeh fails to uncover any teaching or suggestion of the existence of “vacated allocated space”, let alone the separate tracking thereof from “unallocated space”. To further emphasize the difference between these two types of spaces, the independent claims are amended herein to expressly define each space.

In Applicants’ invention, “vacated allocated space” means space that is currently allocated to a port of the plurality of ports, and which has been used to buffer a received packet, but has been vacated as a result of the packet being transferred or discarded. Further, “unallocated space” is defined as space that is not currently allocated to any port of the plurality

of ports. While Valizadeh may track unallocated space, there is no teaching or suggestion therein of tracking vacated allocated space *per se*. Thus, Applicants respectfully submit that the independent claims presented herewith patentably distinguish over Valizadeh, and the other art of record. None of the cited art teaches separately tracking “vacated allocated space” and “unallocated space”. As such, the independent claims presented are believed patentable.

In addition, each of the independent claims presented now qualifies the actively managing as including allocating differently the vacated allocated space and the unallocated space to the plurality of ports. Various dependent claims specify that the actively managing includes offering vacated allocated space to a port to which the vacated allocated space is currently assigned. Since there is no separate tracking of vacated allocated space and unallocated space in Valizadeh, either expressly or inherently, then there can be no different allocation of these spaces to the plurality of ports in Valizadeh. As such, Applicants respectfully submit that the independent claims presented herewith patentably distinguish over the applied art.

For at least the above-noted reasons, Applicants submit that the independent claims presented patentably distinguish over Valizadeh and the other art of record.

The dependent claims are believed to be allowable for the same reasons as the independent claims, as well as for their own additional characterizations.

All claims are believed to be in condition for allowance, and such action is respectfully requested.

Should any issue remain unresolved, however, Applicants' undersigned representative requests a telephone interview with the Examiner to further discuss the matter in the hope of advancing prosecution of the subject application.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Kevin P. Radigan", is written over a horizontal line.

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